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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,064	04/13/2001	Giovanni Giuffrida	HRL065	3890
28848 7590 12/21/2007 TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT 2165	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/835,064

Applicant(s)

GIUFFRIDA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 3, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to Applicant's Amendment filed on December 3, claims 1-16 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's specification uses identical terminology to the claim language in stating the components of the instant invention (independent claims 1 and 9: first processing element, second processing element, etc.) without any further support, explanation, or examples as to what those components are? It is unclear how one of ordinary skill in the art can ascertain the equivalence of those components and how they would be enabling to achieve the invention. Therefore, one can only give the claims their broadest reasonable interpretation without ample support from the specification. There is no embodiment or exemplary evidence of real world examples or computer parts mapped to the "first processing element, second processing element, etc. to understand what they

represent and how they operate in connection with each other. Support in the specification is requested.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-3, 6, 10-11, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the word “substantially” prior to the only example of the subject matter requiring the description in both the claim language and the specification. Therefore, it is unclear how something can be “substantially” format invariant or “substantially” spatial layout facts? The files are either of the form containing invariant format or not? The predetermined information is either spatial layout facts or not? It can’t simply be “substantially” described in those terms. The term renders the claims indefinite. It is well known that “substantially” is a relative term and subject in meaning thus leaving the claims to indefinite and broad.

Claims 8, and 16, both introduce a “storage medium” for storing metadata, it is not clear if it’s the same as the database introduced by claims 1, and 9, or is it a different storage medium, and if that’s the case, how does it tie-in to the remaining claimed limitations. The specification offers no embodiment or examples on what the difference between the two claimed terms is. Clarification is requested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 4-10, and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Copperman et al. (U.S. Patent No. 6,711,585 B1).

As to claims 1, and 9, Copperman et al. discloses an apparatus for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database, wherein,

i) said first processing element is further configured to convert electronic documents into files (See column 12, lines 62-67, also see abstract);

ii) said first processing element is configured to provide the files to a second processing element (See column 18, lines 7-10, and see column 18, lines 44-48);

iii) said second processing element is configured to receive said files and extract predetermined information (See column 2, lines 21-24);

iv) said second processing element is further configured to provide said extracted predetermined information to said reasoning element (See column 2, lines 25-31);

v) said database is configured to also provide input to said reasoning element (See column 13, lines 1-10);

vi) said reasoning element is configured to employ a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database (See column 12, lines 45-51, also see column 13, lines 37-63, wherein "reasoning element" is the processing and analysis done by the "autocontextualization"); and

vii) reasoning element provides an output of metadata (See Figure 22).

As to claims 2, and 10, Copperman et al. discloses an apparatus for automatically extracting metadata from electronic documents, wherein said files are substantially format invariant data files (See column 12, lines 62-67).

As to claims 4, and 12, Copperman et al. discloses wherein the second processing element and said database simultaneously input to the reasoning element (See Figure 5, 510, column 9, lines 38-58).

As to claims 5, and 13, Copperman et al. discloses wherein said set of rules is updated (See column 16, lines 1-13).

As to claims 6, and 14, Copperman et al. discloses wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents (See Figure 2, and see column 13, lines 41-50).

As to claims 7, and 15, Copperman et al. discloses wherein said metadata is provided to a user interface (See Figure 21).

As to claims 8, and 16, Copperman et al. discloses wherein said metadata is provided to a storage medium (See Figure 2, also see column 18, lines 44-48).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman et al. (U.S. Patent No. 6,711,585 B1) in view of Lang and M. Burnett. Knowledge-Based Systems. XML, metadata and efficient knowledge discovery. Pub. 2000. Elsevier Science B.V. (from hereon in Lang et al.)

Copperman et al. teaches the claimed invention but does not explicitly teach wherein said predetermined information is substantially spatial layout facts. However, Copperman et al. teaches maintaining and considering topical distance relationships as well as boundaries of the original document (See Copperman et al. column 16, lines 41-59).

Lang et al. teaches extracting special layout facts (See Lang et al. page 327).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Copperman et al. by the teaching of Lang et al. to include wherein said predetermined information is substantially spatial layout facts because it provides for accurate document presentation to the users (See Lang et al. Page 324).

Response to Amendment

10. The Declaration filed on December 3, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Copperman (Patent No. 6,711,585 B1) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Copperman reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). There are no establishment of dates or notes or any drawing/pointers on behalf of the inventors as to proof conception.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Copperman reference to either a constructive reduction to practice or an actual reduction to practice.

In accordance with MPEP section 715 Three ways to show prior invention:

Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the

reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

Not only is diligence not established by any showing or evidence or proof of continuous work relative to the invention. Since the inventors are unavailable, the assignee must hold some concept paper or email trail or product requirements paper to proof conception and diligence. Instead, Assignee's general counsel is taking the burden of lack of due diligence which is not proper in accordance with MPEP section 715 and certainly unreasonable. Diligence cannot be met because it is unreasonable to fathom a backlog of filing almost two years from the alleged conception to reduction to practice (i.e. from the alleged May 1999 to April 13, 2001).

It is also noted that Appendix A *is missing* which is essential to the declaration to be in compliance with MPEP 15.07 [R-3] titled Facts and Documentary Evidence:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883).

Response to Arguments

11. Applicant's arguments filed on December 3, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that "Applicant's specification page 6, lines 2-4" is sufficient description of enablement as a response to Examiner's 112, first rejection" is respectfully not deemed to be persuasive.

The Applicant's representative himself has offered to further explanation beyond what the Examiner provided in the OA under the rejection. There clearly is no evidence to enable one of ordinary skill in the art at the time the invention was made to perform the invention using the filed specification. The referenced sentence (also published version paragraphs 0022, 0069) only mention the use of a computer or other apparatus having the adequate processing power, without any reasonable examples or explanations as to what is in fact included in the "apparatus" beyond the claimed software components. There is neither examples nor support on how the components interact with each other or how they function together to perform the invention. The apparatus definition alone beyond the mention of personal computer covers wide variety of machines than can range from radio to calculator thus deemed to be unreasonable as claimed. There is no exemplary utility or embodiment on how the "personal/conventional computer" include the elements of the invention and how they interrelate to each other to carry the steps claimed by the invention. There is still no explanation offered to what is meant by "first processing element" and "second processing element"...etc. since conventional personal computers may only have one central processing element. The rejection stands and reasonable clarification is requested.

In response to Applicant's argument that "substantially is well accepted terms in thousands of issued patents" is not deemed to be persuasive.

The Examiner cannot comment on any issued patents; however is requesting clarification on what the term "substantially" means in the context of the instant application's claims? As it is well known in the English language "substantial" means close thus malleable and changeable. A criterion needed to be either identified to be exact or similar (close). The claim should not

contain language that is indefinite and subjective (changeable with time). Is what being claimed is in fact the meaning of "similar" or "close"? Then the use of the word "substantially" is not proper. The specification has not offered the Examiner enough clarification nor support on the use of the word "substantially".

In response to Applicant's argument that "one of ordinary skill in the art would understand that storage medium and database as both are claimed have separate meaning in the art" is not deemed to be persuasive.

The Examiner agrees there could be difference between the two but it is also reasonable to interpret the two to be the same entity and thus raised the rejection, because Applicant's specification is not specific as to what the difference is between the claimed "storage medium" and the claimed "database" and as such could be identified as one and the same or could be interpreted broadly to be "memory" holding "database" in the same computer or the "storage medium" can interpreted to be the same "database" especially since Applicant's specification only mentions the "storage medium" in paragraph 0069 (published version) without any further examples or explanation on why it would be something different than the database. Appropriate explanation in light of the specification is request.

All prior art remarks were made relative to the filing of the Affidavit addressed above and considered improper and insufficient to overcome the prior art rejection.

Conclusion

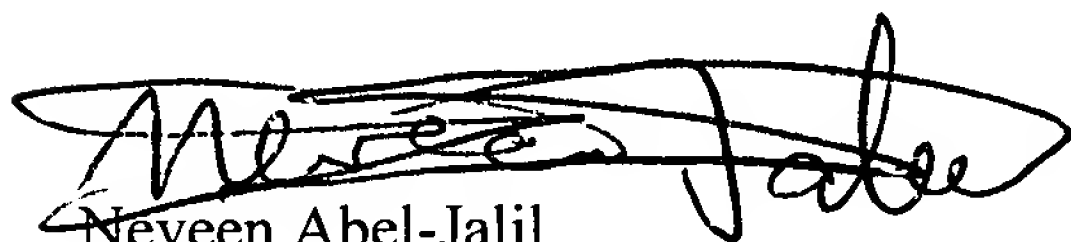
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian P. Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Neeven Jalil', written over a horizontal line.

Neeven Abel-Jalil
Primary Examiner
December 17, 2007